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III. REMARKS

Claims 1-21 are pending in this application. Claims 5, 11, 13 and 18 stand rejected under 35 USC 112, first paragraph, for allegedly failing to provide a best mode regarding the enhancement means for boosting the dynamic range. Claims 1, 4, 7 and 10 stand rejected under 35 USC 103(a) as being unpatentable over Tabata et al. (US 4,618,991) "Tabata," in view of Andrews et al. (Real Time Character Scaling and Rotation) "Andrews." Claims 5 and 11 are rejected under 35 USC 103(a) as being unpatentable over Tabata in view of Andrews, and further in view of Takaoka et al. (US 6,295,385) "Takaoka." Claim 6 is rejected under 35 USC 103(a) as being unpatentable over Tabata in view of Andrews, and further in view of Bergeron et al. (US 6,549,683) "Bergeron." Claims 12 and 17 are rejected under 35 USC 103(a) as being unpatentable over Anderson et al. (US 4,656,664) in view of Andrews. Claims 13 and 18 are rejected under 35 USC 103(a) as being unpatentable over Anderson et al. (US 4,656,664) "Anderson" in view of Andrews, and further in view of Takaoka. Claims 16 and 21 are rejected under 35 USC 103(a) as being unpatentable over Anderson in view of Andrews, and further in view of Bergeron. Claims 2, 3, 8, 9, 14, 15, 19, 20 have been indicated as having allowable subject matter. Applicant greatly appreciates the indication of allowable subject matter.

Applicant does not acquiesce in the correctness of the objections and rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

Rejections under 35 U.S.C. §112, first paragraph

In the Office Action, claims 5, 11, 13 and 18 stand rejected under 35 USC 112, first paragraph, for allegedly failing to provide a *best mode* regarding the enhancement means for boosting the dynamic range. Applicant respectfully traverses this rejection and draws attention to MPEP 2165.03. As stated therein, the “examiner should assume that the best mode is disclosed in the application, unless evidence is presented that is inconsistent with that assumption. It is extremely rare that a best mode rejection properly would be made in *ex parte* prosecution. The information that is necessary to form the basis for a rejection based on the failure to set forth the best mode is rarely accessible to the examiner, but is generally uncovered during discovery procedures in interference, litigation, or other *inter partes* proceedings.”

Unless the examiner has evidence that the inventors had information in their possession (1) at the time the application was filed (2) that a mode was considered to be better than any others by the inventors, a best mode rejection is not proper. See *Chemcast Corp. v. Arco Industries*, 913 F.2d 923, 16 USPQ2d 1033 (Fed. Cir. 1990). In this case, no such evidence exists that the inventor knew of a mode of practicing the claimed invention that the inventor considered to be better than any other. An alleged “lack of details” is not a basis for a best mode rejection. Accordingly, Applicant respectfully requests withdrawal of these rejections.

Applicant also wishes to point out that the specification does indeed disclose an enhancement system and how it can be implemented. “Enhancement system 22 may include, for instance, a look-up table having values that will boost the dynamic range of the image,” (see Specification, page 12).

2. Rejections of independent claims 1 and 7 and dependent claims 4-6 and 10-11 under 35 USC 103(a).

Applicant traverses the rejections to these claims for the following reasons. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In this case, the cited art fails to teach or suggest all the claim limitations. For instance, independent claim 1 (and similarly claim 7) recites “a system for rotating the intermediate reduced image in a direction *opposite* the first direction” The Office Action alleges that Tabata teaches “rotating the image in the opposite direction to the first direction” in column 4, lines 8-42. Applicant submits that no such teaching or suggestion is made. Tabata teaches multiplying the image by cosine θ in the direction of the X axis and then by secant θ in the direction of the Y axis in order to achieve a rotated image. This technique is shown in Figure 1 of Tabata, and clearly does not teach or suggest rotating an intermediate reduced image in a direction *opposite* a first direction. Rather it teaches modifying the image in orthogonal directions (i.e., along the X and Y axes). Accordingly, Applicants submit that because Tabata fails to teach or suggest the aforementioned feature, a *prima facie* case for obviousness of claims 1 and 7 has not been made. Thus, Applicant submits that independent claims 1 and 7 are allowable. Dependent claims 4-6 and 10-12 are believed allowable for the reasons provided above, as well as for their own additional features.

3. Rejections of independent claims 12 and 17 and dependent claims 13, 16, 18, 21 under 35 USC 103(a).

Applicant traverses the rejections to these claims because: there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings; there would be no reasonable expectation of success; and the combination fails to teach each and every claim limitation.

Applicant recites, e.g. in claim 12 (and similarly in claim 17):

“generating an intermediate reduced image having W2 pixels in each row, wherein W2 is less than W1, and wherein for each pixel 1 to W2 in each row, pixel values are calculated based on weighted sums of neighboring pixels in the original image; and

generating a further reduced image having W3 pixels in each row, wherein W3 is less than W2, and wherein for each pixel 1 to W3 in each row, pixel values are calculated based on weighted sums of neighboring pixels in the intermediate reduced image.”

Accordingly, Applicant provides a two step process for pixel reduction including a first step of removing pixels in each *row*, and a second step of removing pixels in each *row*.

Conversely, Anderson teaches removing data along one axis, and then removing data along another axis (see, e.g., Anderson’s claim 1). In other words, Applicant’s two step process operates along only a single axis while Anderson teaches alternating between orthogonal axes. Andrews does not remedy this glaring deficiency. Accordingly, Anderson and Andrews fail to teach or suggest the method and system recited by Applicant.

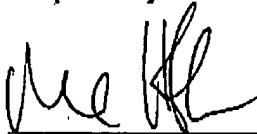
Moreover, Anderson teaches eliminating data by simply deleting lines in the image in between image rotations. For instance Anderson teaches “removing one or more lines of bits

along one of said orthogonal axes... to convert i lines of bits to j lines of bits," rotating the image by 90 degrees, and then "removing one or more lines of bits along the other one of said orthogonal axes" (see, e.g., claim 1). Reduction in Anderson is thus achieved by a combination of 90 degree image rotations and line deletions. There is no teaching or suggestion of modifying Anderson to use a technique such as weighted sums to reduce pixels in row. In fact, such a technique would not work with Anderson, since Anderson eliminates data using the line deletion scheme described above.

Accordingly, Applicant submits that that a prima facie case for obviousness of independent claims 12 and 17 has not been made. Dependent claims 13, 16, 18, and 21 are believed allowable for the reasons provided above, as well as for their own additional features.

Applicant respectfully submits that the application is in condition for allowance. Should the Examiner believe that anything further is necessary to place the application in better condition for allowance, he is requested to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



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